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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,913	06/14/2001	Mitsuru Maeda	35.C15455	5554
5514	7590	02/23/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HENEGHAN, MATTHEW E	
			ART UNIT	PAPER NUMBER
			2134	
DATE MAILED: 02/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/879,913	MAEDA, MITSURU	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-12,14-18,20-22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-12,14-18,20-22 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 December 2005 has been entered.

2. In response to the previous office action, claims 1, 12, 14, 22, and 24-31 have been amended. Claims 1-6, 8-12, 14-18, 20-22, and 24-31 have been examined.

### ***Claim Rejections - 35 USC § 101***

3. In view of Applicant's amendments, all previous rejections under 35 U.S.C. 101 are withdrawn.

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-12, 14-18, 20-22, and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Publication No. 99/48296 to Shamoon et al.

As per claims 1-3, 8-12, 14-16, 20, 22, and 24-31 Shamoon discloses a streaming media system that includes a control block containing data from a Control Stream that is watermarked (i.e. combined into raw data) into audio and visual streams (see p. 7, lines 23-26). The Control is an IPMP (Intellectual Property Management and Protection) component (see p. 4, line 27 and p.5, lines 6-9 and p.21, lines 23-27) of an MPEG-4 stream (see column 4, lines 21-22) that includes rules governing use of intellectual property (see p.12, line 11 to p. 19, line 5). Means for forming control information based upon multiple pieces in intellectual property-related information is disclosed (see column 12, lines 12-20 and figure 7).

Shamoon does not disclose the use of a data field in the intellectual property information that is related to patents or utility models.

However these differences are only found in the nonfunctional data stored on the apparatus or are not functionally involved in the steps recited. Data identifying a particular patent or utility model is not functionally related to the substrate of the apparatus and the forming steps would be performed the same regardless of the data.

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Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the fields of the article of manufacture or to perform forming steps that have any type of intellectual property-related content as shown in Shamoon because such data and steps do not functionally relate to the substrate of the article of manufacture or the steps involved and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claim 4, 17, and 18, the audio and visual streams may be encrypted prior to combining with the control stream (see Shamoon, p.4, lines 28 and 32).

As per claim 5, cryptographic keys for encrypting the data streams are initially contained in the Control Stream before being utilized in the Control Block during decryption (see Shamoon, p.5, lines 8-9 and p. 9, line 30 to p. 10, line 12). Since symmetric keys, such as DES (see p.26, lines 17-19) may be used, the encryption and decryption keys are the same.

As per claim 6, the encoding means is also capable of using public-key signatures (see Shamoon, p. 18, lines 10-13).

As per claim 21, received video is displayed (see Shamoon, p. 6, 19-24).

### ***Response to Arguments***

5. Regarding the rejections under 35 U.S.C. 103, Applicant's arguments filed 2 December 2005 have been fully considered but they are not persuasive. Shamoon discloses a use of IPMP for any type of intellectual property information (copyrights, patents, trademarks, etc.). Since the particular data as recited has been determined to be nonfunctional descriptive material, it does not need to be taught by the prior art. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu, can be reached at (571) 272-3859.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**  
(571) 273-3800

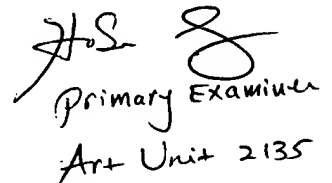
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



February 15, 2006



Primary Examiner  
Art Unit 2135